15866 U.S.PTO 012204

PTO/SB/05 (08-03)
Approved for use through 07/31/2006. OMB 0651-0032
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UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.	1256-00943
First Inventor	Hector F. DeLuca
Title	(20S)-1Alpha-Hydroxy-2Alpha-Methyl and 2Beta-Methyl-19-Nor-Vitamin D3 and Their Uses
Express Mail Label No.	EV383667549US

31353 U.S. PTO 10/762911 012204

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO: **Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450**

1. ☑ Fee Transmittal Form (e.g., PTO/SB/17) *(Submit an original and a duplicate for fee processing)*
2. ☐ Applicant claims small entity status. See 37 CFR 1.27.
3. ☑ Specification [*Total Pages* 38] *(preferred arrangement set forth below)*
 - Descriptive title of the invention
 - Cross Reference to Related Applications
 - Statement Regarding Fed sponsored R & D
 - Reference to sequence listing, a table, or a computer program listing appendix
 - Background of the Invention
 - Brief Summary of the Invention
 - Brief Description of the Drawings *(if filed)*
 - Detailed Description
 - Claim(s)
 - Abstract of the Disclosure
4. ☑ Drawing(s) (*35 U.S.C. 113*) [*Total Sheets* 1]
5. Oath or Declaration [*Total Sheets* 3]
 a. ☐ Newly executed (original or copy)
 b. ☑ Copy from a prior application (37 CFR 1.63(d)) *(for continuation/divisional with Box 18 completed)*
 i. ☐ DELETION OF INVENTOR(S) Signed statement attached deleting inventor(s) name in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76
7. ☐ CD-ROM or CD-R in duplicate, large table or Computer Program *(Appendix)*
8. Nucleotide and/or Amino Acid Sequence Submission *(if applicable, all necessary)*
 a. ☐ Computer Readable Form (CRF)
 b. Specification Sequence Listing on:
 i. ☐ CD-ROM or CD-R (2 copies); or
 ii. ☐ Paper
 c. ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement *(when there is an assignee)* ☐ Power of Attorney
11. ☐ English Translation Document *(if applicable)*
12. ☑ Information Disclosure Statement (IDS)/PTO-1449 ☑ Copies of IDS Citations
13. ☑ Preliminary Amendment
14. ☑ Return Receipt Postcard (MPEP 503) *(Should be specifically itemized)*
15. ☐ Certified Copy of Priority Document(s) *(if foreign priority is claimed)*
16. ☐ Nonpublication Request under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
17. ☐ Other:

18. If a CONTINUING APPLICATION, *check appropriate box, and supply the requisite information below and in the first sentence of the specification following the title, or in an Application Data Sheet under 37 CFR 1.76:*

☐ Continuation ☑ Divisional ☐ Continuation-in-part (CIP) of prior application No.: 10/127,180

Prior application information: *Examiner* Sabiha Naim Qazi *Art Unit:* 1616

For CONTINUATION OF DIVISIONAL APPS only; The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS

☑ Customer Number: 26753 *OR* ☐ Correspondence address below

Name	Thomas M. Wozny				
Address	Andrus, Sceales, Starke & Sawall, LLP				
	100 East Wisconsin Avenue, Suite 1100				
City	Milwaukee	*State*	WI	*Zip Code*	53202-4178
Country	USA	*Telephone*	414-271-7590	*Fax*	414-271-5770

Name (Print/Type)	Thomas M. Wozny	*Registration No. (Attorney/Agent)*	28,922
Signature	Thomas M. Wozny	*Date*	January 22, 2004

This collection of information is required by 37 CFR 1.53(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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PTO/SB/17 (10-03)
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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 770.00

Complet if Known	
Application Number	
Filing Date	January 22, 2004
First Named Inventor	Hector F. DeLuca
Examiner Name	
Art Unit	
Attorney Docket No.	1256-00943

METHOD OF PAYMENT *(check all that apply)*

☑ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit Account Number: 01.2000

Deposit Account Name: Andrus, Sceales, Starke & Sawall, LLP

The Director is authorized to: *(check all that apply)*

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☑ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, **except for the filing fee** to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	$770
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) ($) 770.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims		Fee from below	Fee Paid
Total Claims 10	-20** = 0	X		= 0
Independent Claims 1	- 3** = 0	X		= 0
Multiple Dependent				= 0

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($) 0.00

***or number previously paid, if greater; For Reissues, see above*

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for *ex parte* reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($) 0.00

SUBMITTED BY

(Complete *(if applicable)*)

Name (Print/Type)	Thomas M. Wozny	*Registration No. (Attorney/Agent)*	28,922	*Telephone*	414-271-7590
Signature	Thomas M. Wozny			*Date*	January 22, 2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Divisional Application of:

Hector F. DeLuca
Rafal R. Sicinski
Pawel K. Grzywacz

Title: (20S)-1α-Hydroxy-2α-Methyl and 2β-Methyl-19-Nor-Vitamin D_3 and Their Uses

Attorney Docket: 1256-00943

Parent Application Data:

Application No.: 10/127,180

Filed: April 22, 2002

Examiner: Sabiha Naim Qazi

Group Art Unit: 1616

Title: (20S)-1α-Hydroxy-2α-Methyl and 2β-Methyl-19-Nor-Vitamin D_3 and Their Uses

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as EXPRESS MAIL in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of January, 2004. The Express Mail Label is EV383667549US.

Dorothy A. Hauser — January 22, 2004
Dorothy A. Hauser Date

NOTIFICATION OF THE FILING OF A DIVISIONAL APPLICATION

Mail Stop: Divisional Application
Commissioner of Patents
Alexandria, VA 22313-1450

Sir:

This is a request for filing a divisional application, of pending prior Application No. 10/127,180, filed April 22, 2002, of Hector F. DeLuca, Rafal R. Sicinski and Pawel K. Grzywacz for (20S)-1α-Hydroxy-2α-Methyl and 2β-Methyl-19-Nor-Vitamin D_3 and Their Uses.

1. I hereby verify that the attached papers are a true copy of what is shown in my records to be the above identified parent application, including the Oath or Declaration originally filed. No amendments referred to in the Declaration introduced new matter in the application.

2. The papers of the parent application, as filed, which are attached are as follows:

38 pages of specification
10 claims (after entry of Preliminary Amendment attached hereto)
1 page of abstract
1 sheet of drawing (Figures 1 and 2)
3 pages of Declaration and Power of Attorney

3. The filing fee is computed as indicated in the attached PTO Fee Transmittal (PTO/SB/17).

4. A check in the amount of $770.00 accompanies this application to cover the filing fee pursuant to 37 C.F.R. §1.16. Kindly charge any additional patent filing or processing fees in this divisional application under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 01.2000. An additional copy of this Notification is enclosed.

5. An Information Disclosure Statement is enclosed.

6. A Preliminary Amendment is enclosed.

7. The prior application is assigned of record to Wisconsin Alumni Research Foundation of Madison, Wisconsin and the Assignment is effective to assign the present divisional application to Wisconsin Alumni Research Foundation. The Assignment was recorded on June 13, 2002, at Reel Frame Nos. 146-150.

8. Address for Correspondence - Please address all correspondence to:

ANDRUS, SCEALES, STARKE & SAWALL, LLP
100 East Wisconsin Avenue, St. 1100
Milwaukee, Wisconsin 53202

Please address all telephone calls to:

Thomas M. Wozny
(414) 271-7590

Respectfully submitted,

ANDRUS, SCEALES, STARKE & SAWALL, LLP

By 
Thomas M. Wozny
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